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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,494	04/27/2006	Benjamin Oshlack	200.1163US	8290

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EXAMINER
CLAYTOR, DEIRDRE RENEE

ART UNIT	PAPER NUMBER
1617	

MAIL DATE	DELIVERY MODE
02/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/562,494	OSHLACK ET AL.	
	Examiner	Art Unit	
	Renee Claytor	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/28/2007, 10/6/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Currently claims 1-26 are pending and presented for examination.

Claim Objections

Claims 15-16, 18-21, 23-26 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 101

Claims 24-26 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products,* Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections – 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-26 also rejected under 35 U.S.C. 112, second paragraph. Specifically, since the claimed invention is not supported by either an asserted utility or a well

established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections -35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-14, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshlack et al. (US Pg-Pub 2003/0229111).

Oshlack et al. teach pharmaceutical compositions comprised of naltrexone in amounts of no greater than 0.01 mg and less than 20 mg (paragraph 0016). Table 20A exemplifies a composition comprising naltrexone hydrochloride in an amount of 0.5 mg and hydrocodone bitartrate in an amount of 5 mg, which meets the limitation of claim 1. Tables 22A, 23A, 24A, 25A, 26A and 27A exemplify a composition comprising naltrexone hydrochloride in an amount of 0.125 mg and hydrocodone bitartrate in amount of 5 mg, which meets the limitation of claims 2-3 (meeting the limitation of "about" 7.5 mg hydrocodone). It is further taught that the composition has a sustained release coat and this is accomplished with Eudragit RS30D (see Tables 9A, 10A, 11A, 12A, 13A). The examples associated with Tables 20, 22-27 all teach a process of making the compositions of the invention within the claimed ratio.

Oshlack et al. does not teach compositions with the exact amounts of naltrexone and hydrocodone as listed in claims 2-11 in one composition.

However, it is obvious to vary and/or optimize the amount of hydrocodone and naltrexone provided in the composition, according to the guidance provided by Oshlack et al., to provide a composition having the desired properties such as the desired concentrations of hydrocodone and naltrexone. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). One would be motivated to optimize the amounts of naltrexone and hydrocodone as taught by Oshlack et al. in order to provide maximal pain relief.

Claims 1-14, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (US Pg-Pub 2003/0191147) in view of Kaiko et al. (US PgPub 2003/0031712).

Sherman et al. teach compositions comprised of naltrexone in amounts of about 0.1 to less than about 0.5 mg (paragraph 0058). Paragraphs 0062-0063 exemplify the dose amounts of naltrexone contemplated by the invention and conclude to say that any minimum amount and any maximum amount within range of amounts is possible (paragraph 0064). The composition is taught as also having another ingredient in the way of an opioid agonist such as hydrocodone (paragraph 0068). Paragraphs 0242-0251 exemplify a study in which the composition of the invention was tested in methods

of treating pain. Further controlled release compositions are also contemplated by Sherman et al. (paragraph 0145).

Sherman et al. does not teach the exact amounts of naltrexone and hydrocodone as listed in claims 2-11 in one composition or that the compositions are interdispersed with a sustained release excipient.

Palermo et al. teaches formulations comprising hydrocodone and naltrexone (Col. 5, lines 26-55) can comprise coatings and melt extrusion multiparticulates that aid in releasing the drug over a twelve to twenty-four hour period to provide analgesia (Col. 15, lines 21-27; Col. 23, lines 21-25).

Furthermore, it is obvious to vary and/or optimize the amount of naltrexone and hydrocodone provided in the composition, according to the guidance provided by Sherman et al., to provide a composition having the desired properties such as the desired concentrations of both drugs in an effort to provide maximal pain relief. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Accordingly, one of ordinary skill in the art at the time of the invention would have found it obvious to combine the teachings of Sherman et al. which teaches pharmaceutical compositions and methods of making and using such compositions that are comprised of hydrocodone and naltrexone with the teachings of Palermo et al. which teach similar compositions in which the drugs are interdispersed with sustained release excipients. One would be motivated to do so in an effort to treat pain over a

maximal period of time, to increase patient compliance and to reduce the abuse potential of the opioid agonist.

Conclusion

No claims are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is (571)272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617